UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

wellington

Opposition No. 116,554

Adobe Systems Incorporated

v.

Acro Software, Inc.

Before Hairston, Chapman and Holtzman, Administrative Trademark Judges.

By the Board:

An application has been filed by Acro Software, Inc. to register the mark ACROFORM for "computer software for processing electronic format forms."[1]

Registration has been opposed by Adobe Systems Incorporated under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the ground that applicant's mark, when applied to applicant's goods, so resembles the opposer's "family of well-known marks" as to be likely to cause confusion. Opposer also alleges that it will be injured as a result of registration of applicant's mark because it "causes or threatens to cause dilution of the

[1] Application Serial No. 75/568,499, filed October 13, 1998, alleging dates of first use anywhere and in commerce of June 8, 1998.

distinctive quality of opposer's ACROBAT marks." Opposer specifically relies on the followed registered and common law marks:

> ACROBAT for "computer programs in the field of electronic document storage, manipulation, transfer and retrieval and manuals for use therewith, sold as a unit" in International Class 9;[2]
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> ADOBE ACROBAT for "computer programs in the field of electronic document storage, manipulation, transfer and retrieval and manuals for use therewith, sold as a unit" in International Class 9;[3]
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> ACROBAT EXCHANGE for "computer software used to assist computer users with the creation, storage, manipulation, conversion, transmission, transfer, retrieval, viewing, printing, editing and annotation of documents, and users manuals and instructional books sold as a unit therewith" in International Class 9;[4]
>
> ACROBAT CAPTURE for "page recognition and rendering computer program" in International Class 9;[5]
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> ACROBAT READER for "computer software for page recognition and rendering for use in viewing, printing, navigating, editing, annotating and indexing electronic documents, filling in and submitting forms on-line, and transferring electronic documents via a local or global communications network; computer e-commerce software to allow users to perform electronic business transactions via a local or global communications network; computer software for the encryption and access control of

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[2] Registration No. 1,833,219 issued on April 26, 1994 with dates of first use anywhere and in commerce of June 15, 1993. The Section 8 affidavit was accepted.

[3] Registration No. 1,832,019 issued on April 19, 1994 with dates of first use anywhere and in commerce of June 15, 1993. The Section 8 affidavit was accepted.

[4] Registration No. 1,995,408 issued on August 20, 1996 with dates of first use anywhere and in commerce of April 4, 1993.

[5] Registration No. 1,997,398 issued on August 27, 1996 with dates of first use anywhere and in commerce of May 26, 1995.

electronic documents; and instructional books and manuals sold as a unit therewith" in International Class 9;[6]

ACROBAT for "computer software technical support services in the nature of consulting services, troubleshooting services, help desk services, providing technical information, providing information about computer products and computer product use, providing customer assistance, and providing software updates and tools; computer software development and design for others; consulting services in the field of computer software development and design; providing on-line support services for computer software users, namely, consulting services, troubleshooting services, help desk services, providing technical information, providing information about computer products and computer product use, providing customer assistance, and providing software updates and tools; providing access to computer bulletin boards" in International Class 42; [7]

ACROFORM for "computer programs in the field of electronic document storage, manipulation, transfer and retrieval;"[8]

ACROBAT FORMS for "computer programs in the field of electronic document storage, manipulation, transfer and retrieval."[9]

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[6] Registration No. 1,997,398 issued on August 27, 2001 with dates of first use anywhere and in commerce of May 26, 1995.

[7] Registration No. 2,068,523 issued on June 10, 1997 with dates of first use anywhere and in commerce of June 15, 1993.

[8] In the notice of opposition, opposer alleges common law use of the mark in interstate commerce since at least as early as January 26, 1998. The Board notes that opposer argues in its motion for summary judgment that the mark is used as a common law mark in connection with a file or feature in the ACROBAT software program and that the mark has been in use since as early as 1996.

[9] In the notice of opposition, opposer alleges common law use of the mark in interstate commerce since at least as early as November 1996. The Board notes that opposer argues in its motion for summary judgment that the mark is used as a common law mark in connection with a file or feature in the ACROBAT software program and that the mark has been in use since as early as 1996.

Applicant (pro se), in its answer, denied all of the allegations in the notice of opposition.

This case now comes up for consideration of the parties' cross-motions for summary judgment on the issues of likelihood of confusion and dilution and opposer's motion for discovery sanctions. The motions have been fully briefed.

We turn first to the cross-motions for summary judgment. Opposer argues that there is no genuine issue of material fact in this case as to any of the relevant factors pertaining to likelihood of confusion. Specifically, opposer states that its mark ACROFORM and applicant's ACROFORM mark are identical. Opposer further argues that its ACROBAT "family" of marks and applicant's ACROFORM mark are confusingly similar because they share the same prefix "ACRO"; and that its marks are famous worldwide and that applicant adopted its mark after opposer's marks had acquired such fame.

In addition, opposer argues that confusion is likely between the marks because its goods and services are virtually identical to or closely related to applicant's goods. According to opposer, "the function of the parties' software is virtually identical, with both [opposer's and applicant's] software having the ability to manipulate and process electronic forms and documents." Opposer also

contends that the parties' goods are advertised and purchased through the same channels of trade. Opposer states that applicant sells it software via the Internet and opposer "does likewise, currently authorizing downloads of approximately 1.5 million ACROBAT READER products per week" from its website.

In support of its motion, opposer submitted a declaration of Ms. Sarah Rosenbaum, Director of Product Management for Acrobat Desktop Solutions for opposer corporation; a copy of the signed discovery deposition of Mr. Ching Luo, applicant's President, including Exhibit No. 6 thereto; and a declaration of Mr. Nicholas May, a paralegal with opposer's law firm.

In its response to the motion, applicant asks the Board to deny opposer's motion and to "grant summary judgment in favor of applicant by treating its response as a cross-motion." Applicant argues genuine issues of fact remain as to the following: whether opposer's use of ACROFORM and ACROBAT FORMS qualifies as trademark use; whether a likelihood of confusion exists between applicant's ACROFORM mark and opposer's ACROBAT marks; whether applicant's goods are nearly identical to goods sold by opposer under the ACROBAT marks; and whether applicant intended to trade off opposer's goodwill.

Regarding opposer's use of the terms ACROFORM and ACROBAT FORMS, applicant argues that opposer uses them to designate computer software file names and/or features of the software and that this does not amount to trademark use; and thus opposer does not have any common law rights in the words.

In addition, applicant states that there is no similarity between opposer's ACROBAT marks and applicant's ACROFORM mark. Applicant argues that the dominant element of opposer's marks is "ACROBAT" and this is different from applicant's mark that uses a "generic prefix" of ACRO which, according to applicant, "has its own meaning in the dictionary and is different from ACROBAT."

Applicant has submitted a copy of opposer's responses to applicant's first set of interrogatories, applicant's supplemental responses to opposer's first set of interrogatories, and a declaration of Mr. Ching Luo stating that he conducted an Internet search for the term "ACROBAT" and a copy of the search results.

Summary judgment is appropriate when the record shows that there is no genuine issue of material fact and that the moving party is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). A dispute as to a material fact is genuine only if a reasonable fact finder viewing the entire record could resolve the dispute in the favor of the

nonmoving party. *See Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). In deciding a motion for summary judgment, the Board must view the evidence in the light most favorable to the nonmovant and must draw all reasonable inferences from underlying facts in favor of the nonmovant. *Id*.

We have carefully considered the parties' arguments and evidentiary submissions. For the reasons discussed below, we find that no genuine issue of material fact exists as to the factors bearing on likelihood of confusion, and that opposer is entitled to judgment as a matter of law on its Section 2(d) claim.

In this case, opposer has established through the declaration of Sarah Rosenbaum the status and title of its pleaded registrations and that it acquired common law rights in the marks ACROFORM and ACROBAT FORMS by using them since at least as early as 1996 to identify features of opposer's ACROBAT software that allow users to create a form in the computer user's word processor or other application and convert it to a different format. Applicant's objections based on opposer's use of the ACROFORM and ACROBAT FORMS marks to identify computer software features are not well-taken. Indeed, the Trademark Office recognizes a computer software feature (with additional information as to the purpose of the software and its field of use) as an

acceptable identification of goods. Likewise, opposer therefore has also established priority for its common law marks even assuming that applicant is able to prove its allegation of first use for its mark, ACROFORM, on computer software for processing electronic format forms on June 8, 1998.

Turning to the sound, appearance, and overall commercial impression of the parties' marks, we note that opposer's mark, ACROFORM, is identical to applicant's mark. Applicant's mark, ACROFORM, may be perceived as a shortened version of opposer's mark, ACROBAT FORMS, and likewise is similar in sound, appearance, and overall commercial impression.

As to the similarity in the parties' goods, they are highly related, if not identical. The Rosenbaum declaration establishes that opposer is using the marks ACROFORM and ACROBAT FORMS to identify computer software features of the ACROBAT software that manipulates forms in one software application and converts them into a different format. Applicant has identified its goods as computer software for processing electronic format forms. Applicant's argument that these goods differ from opposer's goods is not well-taken because applicant's identification goods is broad enough to encompass software identical or highly similar to opposer's ACROBAT software containing the ACROFORM and

ACROBAT FORMS features. As evidenced by opposer's Rosenbaum declaration, the ACROBAT FORMS and ACROFORM software simplify the use and completion of third-party forms. Applicant's self-described feature of its software is to "process" electronic format forms. Even if the parties' goods do not include software or software features that perform the identical functions, the field of use or application of the goods is highly related.

Finally, opposer has also established by way of the Luo discovery deposition and the Rosenbaum declaration that the parties' goods share some of the same channels of trade. In his deposition, Mr. Luo stated that applicant sells its good via the Internet. Likewise, opposer has provided evidence that it authorizes downloads of its goods via the Internet and that advertising and sales via the Internet is a common trade channel for computer software. Moreover, applicant has submitted no evidence to show there is any genuine issue as to the channels of trade.

In short, given that opposer's ACROFORM and ACROBAT FORMS marks are either identical or highly similar to applicant's ACROFORM mark, and the similar, if not identical, nature of the parties' goods, and the channels in which they move, we believe there is no genuine issue of material fact which would require a trial for its resolution.

Accordingly, opposer's motion for summary judgment on the ground of likelihood of confusion is granted,[10] applicant's motion for summary judgment is denied, the opposition is sustained, and registration of applicant's mark is refused.[11]

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[10] In view of the above decision, opposer's motion for summary judgment on the issue of dilution is moot.

[11] Opposer's motion for discovery sanctions is denied. Opposer has not demonstrated that applicant violated the Board's November 27, 2001 order wherein the Board required applicant to "confer with opposer…to resolve the matters raised in opposer's amended motion to compel." From the record before us, applicant did confer with opposer in an attempt to resolve the outstanding discovery issues after receiving the Board's order.